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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,800	09/30/2003	Kerry Sellen	1DATA.114A	3679
20995 7590 03/25/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER				
LE, UYEN CHAU N				
ART UNIT		PAPER NUMBER		
2887				
NOTIFICATION DATE		DELIVERY MODE		
03/25/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
eOAPilot@kmob.com

Office Action Summary

Application No.

10/674,800

Applicant(s)

SELLEN ET AL.

Examiner

Uyen-Chau N. Le

Art Unit

2887

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-86 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/DE)
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :05/27/2004; 08/16/2005; 02/15/2008.

DETAILED ACTION

Double Patenting

1. Claims 1 and 13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. US 7331514 B2 (hereinafter '514). Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims 1 and 13 of the present application and the claim 1 of the patent '514 are almost identical. The only difference between the present claimed invention and the '514 patent is that the present claimed invention is a broader recitation of the '514 patent.

Claims 1 and 13 of the present application recite a system and method of conducting a financial transaction comprising: **"receiving an electronic information about a check** from a subscribing merchant; determining whether the electronic information about the check includes an indicator that indicates the presence of an auxiliary on-us field on a magnetic ink character recognition (MICR) associated with the check wherein the presence of the auxiliary on-us field denotes that the check is a corporate check; and **performing a risk assessment for the corporate check** based at least in part on the electronic information to thereby authorize or decline the corporate check." whereby claim 1 of the patent to '514 recites a system and method of conducting a financial transaction comprising: **"obtaining information about a financial transaction** to allow at least a portion of subsequent processing of the financial transaction to be performed electronically wherein the information is obtained via an electronic device associated with a merchant involved in the financial transaction; **determining whether the financial transaction is a corporate type transaction** based on the presence of a field associated with the

information, wherein the determination is performed at the electronic device associated with the merchant;... **performing a risk assessment of the financial transaction** to authorize or decline the financial transaction when the financial transaction passes the merchant-defined rules...”

Thus, with respect to above discussions, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the teaching of claim 1 of the patent ‘514 as a general teaching for having a system and method of conducting a financial transaction with the same functions as claimed by the present application. The instant claims obviously encompass the patented claims and differ only in terminology. To the extent that the instant claim is broaden and therefore generic to the patented claims [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been patented.

The obviousness-type double patenting rejection is a judicially established doctrine base upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. Sec 37 C.F.R § 1.78(d).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 25-28, 35-37, 39-45, 52-54, 56-62, 69-71, 73-80 and 85-86 are rejected under 35 U.S.C. 102(e) as being anticipated by Koakutsu (US 6902105 B2 - cited by the Applicant).

Re claims 25-28, 35-37, 39-45, 52-54, 56-62, 69-71, 73-80 and 85-86: Koakutsu discloses a method of authorizing a check transaction involving a subscribing merchant, the method comprising:

receiving information about the check transaction from the subscribing merchant wherein the information about the check transaction allows at least a portion of subsequent processing of the check transaction to be performed electronically (fig. 16; col. 12, lines 16+);

determining whether the information about the check transaction includes an indicator that indicates that the check transaction involves a corporate check (fig. 16; col. 12, lines 20-30);
and

determining whether to authorize or decline the check transaction as a corporate check transaction based on the presence of the indicator and the information about the check transaction (fig. 16; col. 12, lines 20+).

wherein receiving information comprises receiving electronic information about the check transaction (col. 12, lines 16+).

wherein the indicator indicates the presence of auxiliary on-us field on a magnetic ink character recognition (MICR) information associated with the check transaction (col. 12, lines 18-29).

wherein determining whether to authorize or decline the check transaction as a corporate check transaction comprises determining whether the subscribing merchant is allowed to process corporate checks, wherein the subsequent electronic processing of the corporate check proceeds if the subscribing merchant is allowed to process corporate checks (col. 12, lines 20+).

wherein the information about the check transaction is obtained by an electronic device (i.e., MICR unit 12) associated with the subscribing merchant (fig. 7; col. 8, lines 5-13).

wherein the electronic device associated with the subscribing merchant comprises a check scanner adapted to capture an image of at least a portion of the check wherein the check scanner is further adapted to read the check's MICR (fig. 7; col. 8, lines 8-13).

wherein the electronic device associated with the subscribing merchant comprises a computer adapted to receive inputs associated with processing of the corporate check (col. 8, lines 14-33).

further comprising obtaining and retaining an image of at least a portion of a check associated with the check transaction upon determination that the check transaction is a corporate check transaction (col. 12, lines 29-38).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-3, 5-15, 17-24, 29, 31-34, 38, 46, 48-51, 55, 63, 65-68, 72 and 82-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koakutsu in view of Templeton et al (US 5679940 A - cited by the Applicant). The teachings of Koakutsu have been discussed above.

Re claims 1-3, 5-15, 17-24, 29, 31-34, 38, 46, 48-51, 55, 63, 65-68, 72 and 82-84: Koakutsu discloses a method of authorizing electronic processing of a corporate check received at a merchant location, the method comprising:

receiving an electronic information about a check from a subscribing merchant (fig. 16; col. 12, lines 16+);

determining whether the electronic information about the check includes an indicator that indicates the presence of an auxiliary on-us field on a magnetic ink character recognition (MICR) associated with the check wherein the presence of the auxiliary on-us field denotes that the check is a corporate check (fig. 16; col. 12, lines 20-30).

Further comprising, after receiving the electronic information from the subscribing merchant, determining whether the subscribing merchant is allowed to process corporate checks electronically, wherein the subsequent electronic processing of the corporate check proceeds if the subscribing merchant is allowed to process corporate checks electronically (fig. 16; col. 12, lines 30-38).

wherein the electronic device associated with the subscribing merchant comprises a check scanner adapted to capture an image of at least a portion of the check wherein the check scanner is further adapted to read the check's MICR (fig. 7; col. 8, lines 8-13).

wherein the electronic device associated with the subscribing merchant comprises a computer adapted to receive inputs associated with processing of the corporate check (col. 8, lines 14-33).

further comprising obtaining and retaining an image of at least a portion of the check upon determination that the check is a corporate check (col. 12, lines 30-38) .

Koakutsu is silent with respect to performing a risk assessment for the corporate check based at least in part on the electronic information to thereby authorize or decline the corporate check; wherein the risk assessment depends at least to some degree on a level of service subscribed by the merchant; wherein the level of service includes guaranteeing the authorized check or purchasing the check from the subscribing merchant thereby assuming at least some of the risk associated with the check; wherein determining the subscribing merchant's status is facilitated by a merchant, setup system having a profile of the subscribing merchant wherein the profile includes data that determines how check transactions associated with the subscribing merchant are to be processed; wherein the electronic device associated with the subscribing merchant comprises a telephone based device adapted to perform a telephone based financial transaction, respectively.

Templeton et al teaches a transaction system comprises performing a risk assessment for the corporate check based at least in part on the electronic information to thereby authorize or decline the corporate check (col. 11, lines 9+; col. 14, lines 1-63; col. 28, lines 12+); wherein the risk assessment depends at least to some degree on a level of service subscribed by the merchant; wherein the level of service includes guaranteeing the authorized check or purchasing the check from the subscribing merchant thereby assuming at least some of the risk associated with the check (col. 19, lines 16-34); wherein determining the subscribing merchant's status is facilitated by a merchant, setup system having a profile of the subscribing merchant wherein the profile includes data that determines how check transactions associated with the subscribing merchant are to be processed (col. 12, line 66 through col. 13, line 2 and col. 27, lines 54-59); wherein the electronic device associated with the subscribing merchant comprises a telephone based device

adapted to perform a telephone based financial transaction (figs. 3 and 4; col. 16, lines 47+ and col. 17, lines 21+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Templeton et al into the system as taught by Koakutsu in order to provide Koakutsu with a more secure system with capability of ensuring a complete and accurate evaluation of whether to approve or decline a check transaction via the risk assessment system (i.e., the preferred risk assessment system uses a profitability coring model to evaluate the overall profitability of a transaction and utilizes the result as a key indicator in determining whether to approve or decline a transaction), and therefore an obvious expedient.

7. Claims 4 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koakutsu as modified by Templeton et al as applied to claims 1 and 13 above, and further in view of Repak (US 20030229586 A1). The teachings of Koakutsu as modified by Templeton et al have been discussed above.

Koakutsu/Templeton et al is silent with respect to allows the check processing service to process the check as a cash concentration disbursement (CCD) transaction via an automated clearing house (ACH) if the check is a corporate check.

Repak teaches an Automated Clearing House (ACH) file 135 typically comprises a standard entry class (SEC) code including CCD (cash concentration and disbursement) used for corporate payment applications that provide the ability to collect and disburse funds and information between companies, CTX (commercial trade exchange) used for corporate payment

applications originated by an Originator to pay or collect an obligation of such Originator and destined for the account of another organization (paragraphs [0006] and [0021]).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the cash concentration and disbursement method of Repak into the system as taught by Koakutsu/Templeton et al in order to provide Koakutsu/Templeton et al with a time consumption system wherein in no further action is required (e.g., generating a credit reversal and posted to the account for authorization), thus the user can get the cash instantaneously.

8. Claims 30, 47, 64 and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koakutsu in view of Repak (US 20030229586 A1). The teachings of Koakutsu have been discussed above.

Koakutsu is silent with respect to allows the check processing service to process the check as a cash concentration disbursement (CCD) transaction via an automated clearing house (ACH) if the check is a corporate check.

Repak teaches an Automated Clearing House (ACH) file 135 typically comprises a standard entry class (SEC) code including CCD (cash concentration and disbursement) used for corporate payment applications that provide the ability to collect and disburse funds and information between companies, CTX (commercial trade exchange) used for corporate payment applications originated by an Originator to pay or collect an obligation of such Originator and destined for the account of another organization (paragraphs [0006] and [0021]).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the cash concentration and disbursement method of Repak

into the system as taught by Koakutsu in order to provide Koakutsu with a time consumption system wherein in no further action is required (e.g., generating a credit reversal and posted to the account for authorization), thus the user can get the cash instantaneously.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patent listed below is cited as of interest and illustrate a similar structure to Systems and Methods For Determining Financial Transaction Types.

Lowery (US 6189785 B1) discloses a deposit processing system in which the central computer system to communicate with the data source to settle the transaction on line or through traditional *automated clearing house channels*.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on maxi-flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven S. Paik can be reached on 571-272-2404. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Uyen-Chau N. Le/
Primary Examiner, Art Unit 2887

February 27, 2008